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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,625	01/17/2001	Qi Wang	6956CIP	5289

7590 12/17/2003  
Occidental Chemical Corporation  
Patent Department  
5005 LBJ Freeway  
Dallas, TX 75244-6119

EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 12/17/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

113

# Office Action Summary

Application No.

09/761,625

Applicant(s)

WANG, QI

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-48 is/are pending in the application.
- 4a) Of the above claim(s) 29,30,35,37,40,41 and 43 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28,47 and 48 is/are allowed.
- 6) ☒ Claim(s) 25-27,31-34,36,38,39,42 and 44-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims 29, 30, 35, 37, 40, 41 and 43 drawn to inventions nonelected in Paper No. 4. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 25-27, 31-34, 36, 38, 39, 42 and 44-46 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the stabilizer compounds in the examples, still does not reasonably provide enablement for the multitude of stabilizer compounds of claims 25 or 44, from which the remaining claims depend.

### ***Allowable Subject Matter***

4. Claims 28, 47 and 48 are allowable for reasons cited in the previous actions.

***Response to Arguments***

5. Applicant's arguments filed 11/3/03 have been fully considered but they are not persuasive.

6. Regarding the 112, 1<sup>st</sup> ¶ rejections, the blanket statements of generic mechanisms and allegedly commercially available compounds in the declaration by Dr. Wang are still not sufficient evidence that applicant, at the time the application was filed, provided a description that enables each and every claimed stabilizer, even with the current narrowing of these claims.

Applicant states that some of the stabilizers are commercially purchased, however, the mere statement that the compounds are commercially available is not evidence in itself of such for all the stabilizers.

The first paragraph of 35 U.S.C. § 112 requires a reasonable correlation between the scope of what is claimed and the scope of enablement **provided by applicant's specification** to the person of ordinary skill in the art. **There is simply no recitation in the original specification to reasonably provide enablement for the multitude of stabilizer compounds recited in the claims.** There is nothing of record to indicate that the person of ordinary skill in the art would be enabled by the original specification to **make and use all** the claimed stabilizer compounds, commensurate in scope with these claims. In re Vaeck, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Applicant has

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not shown a representative sample of the stabilizers within the scope of the present claims.

Other than some non-specific mechanisms for preparing a **small** number of the compounds applicant intends to claim and the statement that **some** other small number of the compounds applicant intends to claim are commercially available, wherein the other unidentified compounds can be made by other unidentified but allegedly well-known techniques in the art, how to prepare **all** the compounds of the rejected claims is simply not set forth in applicant's disclosure.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.



KCE

**KELECHI C. EGWIM PH.D.  
PRIMARY EXAMINER**